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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/171,909

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Jayanta Roy-Chowdhury

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EXAMINER

SCHWADRON, RONALD B

ART UNIT

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1644

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/171,909	Applicant(s) ROY-CHOWDHURY ET AL.	
	Examiner Ron Schwadron, Ph.D.	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/13/07 has been entered.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide adequate written description of the claimed invention. The legal standard for sufficiency of a patent's (or a specification's) written description is whether that description "reasonably conveys to the artisan that the inventor had possession at that time of the . . . claimed subject matter", *Vas-Cath, Inc. V. Mahurkar*, 19 U.S.P.Q.2d 1111 (Fed. Cir. 1991). In the instant case, the specification does not convey to the artisan that the applicant had possession at the time of invention of the claimed inventions.

The instant claims encompass a method that uses "selective immune down regulation" (SIDR). However, the only such reagents/methods for establishing SIDR are those disclosed in the specification, page 17. The claims encompass use of a vast genus of undisclosed agents that could be used to induce selective immune down regulation. Furthermore, even regarding known immunomodulating agents, it is unclear as to what agents could or could not produce selective immune down regulation as per the definition of said term in the specification. The reagent used in the claimed method

is defined in terms of a functional activity with no structural information provided. There is no disclosed (or known) correlation between the functional activity and the structure of an agent that can induce "selective immune down regulation". Adequate written description requires more than a mere statement that it is part of the invention and a reference to a potential method of isolating it. In the instant application, the amino acid itself or isolated peptide is required. See *Fiers v. Revel*, 25 USPQ 2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

In view of the aforementioned problems regarding description of the claimed invention, the specification does not provide an adequate written description of the invention claimed herein. See *The Regents of the University of California v. Eli Lilly and Company*, 43 USPQ2d 1398, 1404-7 (Fed. Cir. 1997). In *University of California v. Eli Lilly and Co.*, 39 U.S.P.Q.2d 1225 (Fed. Cir. 1995) the inventors claimed a genus of DNA species encoding insulin in different vertebrates or mammals, but had only described a single species of cDNA which encoded rat insulin. The court held that only the nucleic acids species described in the specification (i.e. nucleic acids encoding rat insulin) met the description requirement and that the inventors were not entitled to a claim encompassing a genus of nucleic acids encoding insulin from other vertebrates, mammals or humans, *id.* at 1240. The Federal Circuit has held that if an inventor is "unable to envision the detailed constitution of a gene so as to distinguish it from other materials. . .conception has not been achieved until reduction to practice has occurred", *Amgen, Inc. v. Chugai Pharmaceutical Co, Ltd.*, 18 U.S.P.Q.2d 016 (Fed. Cir. 1991). Attention is also directed to the decision of *The Regents of the University of California v. Eli Lilly and Company* (CAFC, July 1997) wherein is stated: "The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material. Thus, as we have previously held, a cDNA is not defined or described by the mere name "cDNA," even if

accompanied by the name of the protein that it encodes, but requires a kind of specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the cDNA." See Fiers, 984 F.2d at 1171, 25 USPQ2d at 1606.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (WO 96/39176) in view of Katz (US Patent 4,950,469). Applicants arguments have been considered and deemed not persuasive.

Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent autoantigen (see claims 1-13, pages 12-14,40,41). Oral tolerance is a form of "selective immune down regulation" (see specification, page 17, second paragraph). Chen et al. do not teach that the disease provoking antigen is streptococcus which is involved with the pathogenesis of rheumatic fever. Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti

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streptococcal antibodies which cross react with human tissues (see column 6, first). Katz teaches that agents which prevent binding of said antibodies could be used to treat rheumatic fever (see column 6, first paragraph). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have created the claimed invention because Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent

autoantigen whilst Katz teaches that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues wherein the streptococcal antigens would function as an autoantigen. One of ordinary skill in the art would have been motivated to do the aforementioned because Chen et al. teach use of oral tolerance to prevent antibody responses causing autoimmune diseases and Katz disclose that anti streptococcal antibodies are involved in rheumatic fever and that neutralization of said antibodies could be used to treat said disease.

Regarding applicants comments about what constitutes a proper rejection under 35 USC 103, said comments ignore KSR Int'l Co. v. Teleflex Inc.. Regarding applicants comments about Chen et al. and the term autoantigen, Chen et al. state in page 8, lines 18-20 of said page that regarding the term autoantigen that "*The term also includes antigenic substances that induce conditions having the characteristics of an autoimmune disease when administered to mammals.*". Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues. Thus the streptococcal antigen as per disclosed by Katz would constitute an autoantigen as per the definition of said term in Chen et al. In KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 WL 1237837, at *13 (2007) it was stated that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill".

Regarding applicants comments, Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent autoantigen and wherein oral tolerance is a form of "selective immune down regulation" (see specification, page 17, second paragraph). While Chen et al. do not teach that the disease provoking antigen is streptococcus which is involved with the pathogenesis of rheumatic fever, Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues. Chen et al. state in page 8, lines 18-20 of said page that regarding the term autoantigen that "*The term also includes antigenic substances that induce conditions having the characteristics of an autoimmune disease when administered to mammals.*". Regarding applicants comments about "artificial antigens" and animal models, Chen et al. disclose the use of antigens in humans that are associated with human autoimmune diseases (see pages 17-18). Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent autoantigen and wherein oral tolerance is a form of "selective immune down regulation" (see specification, page 17, second paragraph). While Chen et al. do not teach that the disease provoking antigen is streptococcus which is involved with the pathogenesis of rheumatic fever, Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues. Chen et al. state in page 8, lines 18-20 of said page that regarding the term autoantigen that "*The term also includes antigenic substances that induce conditions having the characteristics of an autoimmune disease when administered to mammals.*".

Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues. Thus the streptococcal antigen as per disclosed by Katz would constitute an autoantigen as per the definition of said term in Chen et al.

Regarding applicants comments, there is currently no limitation in the claims regarding the dosage of antigen that is used in the claimed method. Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent autoantigen and wherein oral tolerance is a form of "selective immune down regulation" (see specification, page 17, second paragraph). Thus, Chen et al. teach a method of "selective immune down regulation". Applicants arguments involve limitations not recited in the claims under consideration. Regarding applicants comments about "high dose feeding", the method of Chen et al. is not limited to a method of "high dose feeding". For example, in claim 1 of Chen et al., the autoantigen is administered at a dosage wherein the autoimmune disease is treated. Thus, the method of Chen et al. does not require "high dose feeding". In fact, Chen et al., page 16, last paragraph teach:

"As will be understood by those skilled in the art, the dosage will vary with the disease, the antigen administered and may vary with the sex, age, and physical condition of the patient as well as with other concurrent treatments being administered. Consequently, adjustment and refinement on one or both of the dosages used and the administration schedules will be determined based on these factors and especially on the patients response to the treatment. Such determinations, however, require no more than routine experimentation..."

Furthermore, there is no disclosure in the specification of the instant application that any particular dosage of antigen is required to practice the instant invention in humans. The specification, page 12 states:

"This invention provides a process for producing selective immune down regulation in a subject to an infectious bacterial agent. In this process, a reagent or a combination of reagents capable of producing selective immune down regulation and comprising a component or components or fragments thereof of such

infectious agent is introduced to the subject, thereby establishing selective immune down regulation in the subject.”.

Thus, the reagent is simply administered at a concentration that results in selective immune down regulation (such as oral tolerance).

Regarding the specification, Example 1, said example is not drawn to the claimed method (it does not use a bacterial antigen) and is therefore irrelevant to the invention under consideration. Said example also refers to a specific dosage range wherein said range is not the dosage encompassed by the term “large amounts of antigen” as per Chen et al. It is also noted that none of the claims under consideration recite the administration of any particular concentration of antigen. Regarding applicants comments about Katz, said reference discloses that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues (see column 6, first paragraph). Katz then discloses that said disease can be treated using an agent that interferes with said antibodies (see column 6, first paragraph). Thus Katz clearly discloses the role of said antigen in rheumatic fever. In addition, Chen et al. disclose that particular antigens can be identified by screening antigens for binding with antibodies from a patient (see page 18, penultimate paragraph).

Chen et al. teach that oral tolerance to autoantigens can be used to treat antibody mediated autoimmune disease wherein the disease involves antibodies which bind the pertinent autoantigen and wherein oral tolerance is a form of “selective immune down regulation” (see specification, page 17, second paragraph). While Chen et al. do not teach that the disease provoking antigen is streptococcus which is involved with the pathogenesis of rheumatic fever, Katz et al. teach that rheumatic fever involves an autoimmune antibody response caused by anti streptococcal antibodies which cross react with human tissues.

6. No claim is allowed.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached on Monday-Thursday 7:30-6:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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